

REMARKS

This paper is responsive to an Office Action dated June 28, 2005. Prior to this response, claims 1-23 were pending. After amending claims 13, 18, and 20, claims 1-23 remain pending.

Section 2 of the Office Action objects to the word “comprises” in the Abstract. In response, the Abstract has been amended to replace the word “comprises” with the word –includes--.

Section 3 of the Office Action objects to the title. In response, the as-filed title has been canceled and a new title substituted for the original title. The new title is: SYSTEM AND METHOD FOR USING A PRINTER TO COLLATE A DOCUMENT.

Section 4 of the Office Action objects to the drawings. Replacement drawings are enclosed as Attachment A.

In Section 6 of the Office Action claims 1-4, 8-16, and 20-23 have been rejected under 35 U.S.C. 102(e) as anticipated by Anderson et al. (“Anderson”; US 6,646,758). The Office Action states that Anderson describes all the elements of claims 1 and 13. This rejection is traversed as follows.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Generally, Anderson describes an intelligent media and feature selection that is controlled by embedded printer programs. The printer is able to automatically provide a type of media for a print job that

most closely resembles the media requested by the user (col. 2, ln. 55 – col. 3, ln. 14). Anderson's printer includes a collator unit 62 that "is configured to receive print media (post printing) from print unit 50 and to selectively control the handling of the print media." (col. 6, ln. 16-18).

A key point to note is that Anderson can only collate a print job (post printing), as the output of print unit 50. Anderson's describes a conventional collator that is able to divide a print job into different trays, and/or staple the job. With respect to claim 1, Anderson does not create a collated document, from document sections that are loaded into input media trays. At best, Anderson can be said to create a collated document from *modified* document sections. In the simplest case, a document section could be a blank sheet. Anderson could modify the blank sheet by printing on it, creating a collated document from the modified (printed) blank sheet. Even if preprinted sheets are loaded into the input trays, Anderson creates a collated document by modifying (printing over) the preprinted sheets. Alternately stated, Anderson accepts a sheet from an input tray, and can only collate a job after it has printed on the sheet received from the input tray.

With respect to claim 13, the issues are the same. Although Anderson can select media from different input trays, he can only collate a job output by the print unit 50. Anderson does not describe a media routing system that interfaces between input trays and output trays, to supply a collated document comprising document sections from the input trays. Again, Anderson does not create a collated document from document sections in the input trays. Anderson must first modify the document sections by printing on them.

The Office Action also states that the claimed method steps are inherent from the product. The Applicant respectfully submits that this analysis is incomplete, as similar products can be made as a result of different processes.

“Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Anderson’s product is a collated print job. Anderson does not show that his printer has the inherent capability to collate document sections that are loaded into input trays, without first modifying the document sections, as the claimed invention.

With respect to claim 1, Anderson does not describe the step of creating a collated document from document sections loaded in the input media trays. With respect to claim 13, Anderson does not describe a printer with a media routing system that supplies a collated document comprised of document sections loaded in the input media trays. Since Anderson does not explicitly describe every element of claims 1 and 13 he cannot anticipate. Claims 2-4 and 8-12, dependent from claim 1, and claims 14-16 and 20-23, dependent from claim 13, enjoy the same distinctions from the cited prior art and the Applicant respectfully requests that the rejection be removed.

In Section 8 of the Office Action claims 5 and 17 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Anderson, in view of Holzwarth et al. (“Holzwarth”; US 2004/0190066). The Office Action acknowledges that Anderson does not describe collation command

formats, but states that it would have been obvious to use the formats disclosed by Holzwarth in the Anderson invention, to make claims 5 and 17 obvious. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

As mentioned above, Anderson generally describes automated printer processes. Anderson does not describe a collation controller. This follows from the fact that Anderson does not describe a collation driver application that can be used to command the collation processes described in Applicant's claims 1 and 13. In paragraph [0027] Holzwarth describes conventional formats that may be used for print jobs.

With respect to the first *prima facie* requirement, there is no suggestion that Anderson be modified by Holzwarth in a way that makes the claimed invention obvious. Neither reference describes a collation controller or a collation driver application. Therefore, the combination of references cannot make obvious a format used by a collation driver.

With respect to the second *prima facie* requirement, even if an expert were given the Anderson and Holzwarth inventions as a foundation, there is no reasonable expectation that this expert could derive the claimed invention, since the claimed invention recites processes that are described by neither reference.

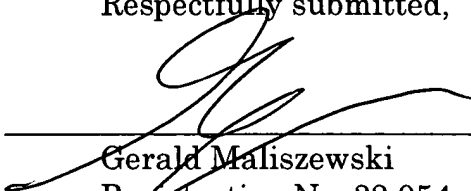
With respect to the third *prima facie* requirement, even if the references can be combined, they do not disclose all the elements of the base claims from which claims 5 and 17 depend. Neither reference describes a device/method that is able to create a collated document of document sections, where the document sections are loaded in input trays. Neither reference explicitly describes these limitations. Neither does the combination of reference suggest modifications that would make these particular limitations obvious. Claim 5, dependent from claim 1, and claim 17, dependent from claim 13, enjoy the same distinctions from the cited prior art, and the Applicant requests that the rejection be removed.

Section 9 of the Office Action states that claims 6, 7, 18, and 19, would be found allowable if rewritten in independent form including all the limitations of the base and intervening claims.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

Date: 8/15/2005



Gerald Maliszewski
Registration No. 38,054

Customer Number 55,286
P.O. Box 270829
San Diego, CA 92198-2829
Telephone: (858) 451-9950
Facsimile: (858) 451-9869
gerry@ipatentit.net

ATTACHMENT A